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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/336,328 06/18/99 BURNS P 50351/10-488

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EXAMINER

MOEZIE, F

ART UNIT

PAPER NUMBER

1653

7

DATE MAILED:

09/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.
09/336,328

Applicant(s)
Burns

Examiner
F. T. Moezie

Group Art Unit
1653



☒ Responsive to communication(s) filed on Sep 1, 1900

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-26 is/are pending in the application.

Of the above, claim(s) 18-26 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-17 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-26 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

STATUS OF CLAIMS

Claims 1-17 are pending prosecution in this Office action.

In response to the prior Office action, Restriction Requirement, mailed 08 July 2000, applicant elected Group I invention, claims 1-17, with traverse. Applicant also elected deslorelin specie in response to the Species Election.

The traversal of the restriction requirement on the ground that "the examination of the entire application would not impose an undue burden" has been considered but not found persuasive because: Assuming arguendo that the compositions are found patentable the various methods of use, ie, methods of treating diverse hosts for different conditions in dissimilar environments would call for separate library and computer searches. Because the hosts are different, the methods of treating in various environments are different, the consideration of patentability would be different in each case. Hence, the restriction requirement is deemed proper and maintained.

SPECIFICATION - OBJECTION

The specification is objected to regarding the use of the terms "analogs" and "agonists" interchangeably. At page 6, line 22, of the specification "analog is selected from deslorelin---", whereas at page 10, Table 1, deslorelin is cited amongst agonists. Applicant is advised to remain consistent and adopt one terminology throughout to avoid confusion.

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REJECTION - 35 USC 112, SECOND PARAGRAPH

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "analogs or agonists" render the claims indefinite as to the claims' metes and bounds. How do "analogs" differ from "agonists"?

Claims 11 and 12 are duplicative of claim 1 being drawn to the same composition.

STATUTORY DOUBLE PATENTING

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-6 and 8-10 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-6 and 8-10 of prior U.S. Patent No. 6,051,558. This is a double patenting rejection.

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CONCLUSION

No claims are allowed.

Any inquiry concerning this communication should be directed to F.T. Moezie at telephone number (703) 305-4508 or Mr. LOW at 308-2023. FAX: (703)305-7401

F. T. Moezie
F. T. MOEZIE, Ph.D.
PRIMARY EXAMINER
ART UNIT 1653